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E-FILING

**UNITED STATES DISTRICT COURT
 NORTHERN DISTRICT OF CALIFORNIA
 SAN FRANCISCO DIVISION**

Visto Corporation)	CASE NO.: 04-0651 EMC
)	
Plaintiff,)	Before the Honorable Edward M. Chen
)	
v.)	RESPONSE TO VISTO CORPORATION'S
)	SUPPLEMENTAL FILING REGARDING
)	MOTION FOR PRELIMINARY
Sproqit Technologies, Inc.)	INJUNCTION
)	
Defendant.)	Hearing Date: January 18, 2006
)	Time: 2:30 PM
)	Courtroom: Courtroom C, 15th Floor
)	Judge: Edward M. Chen

The Court asked Visto to explain the use of the term “bookmark” in the ‘192 Patent, which is the only patent at issue in Visto’s motion for a preliminary injunction. Instead, Visto spends the bulk of its supplemental memorandum discussing five *other* patents – including patents that were filed after the ‘192 Patent. The mere fact that Visto finds it necessary to seek

1 succor in these other patents demonstrates that a substantial question exists about the ‘192
2 Patent. The existence of a substantial question defeats the motion for preliminary injunction.
3 Amazon.com, Inc. v. Barnesandnoble.com, Inc., 239 F.3d 1343, 1350-51 (Fed. Cir. 2001).

4 Moreover, Visto’s desperate attempt to take refuge in the language of the other patents
5 constitutes an admission that the language Visto needs is not in the ‘192 Patent itself. This
6 further bolsters Sprokit’s argument that a substantial question exists regarding the ‘192 Patent.
7 At best, the evidence from these other patents raises a complicated issue of claim construction
8 that should be handled pursuant the Patent Local Rules’ orderly claim-construction procedure –
9 not disposed of on a motion for preliminary injunction. The motion for preliminary injunction
10 should therefore be denied.
11

12 In any event, Visto cannot retroactively expand the disclosure of the ‘192 Patent and
13 broaden the scope of its claims by relying on language included in later applications that claim
14 priority to the ‘192 Patent. Visto refers, for example, to language from the written description of
15 the ‘606 Patent, which issued from an application filed in 1998. The language Visto cites from
16 the written description of the ‘606 Patent does not appear in the ‘192 Patent. Section 112 of the
17 patent statute, 35 U.S.C. § 112(1), requires that a patent contain a written description of the
18 invention. The written description requirement is intended to “put the public in possession of
19 what the party claims as his invention.” Vas-Cath v. Mahurkar, 935 F.2d 1555, 1561 (Fed. Cir.
20 1991), quoting Evans v. Eaton, 20 U.S. 356, 434 (1822). The written description requirement
21 prevents a patentee from later claiming more than he invented:
22
23

24 Adequate description of the invention guards against the inventor’s
25 overreaching by insisting that he recount his invention in such
26 detail that his future claims can be determined to be encompassed
27 within his original creation.
28

1 Vas-Cath, 935 F.2d at 1561, quoting Rengo Co. v. Molins Mach. Co., 657 F.2d 535, 551 (3d
2 Cir.), cert. denied, 454 U.S. 1055 (1981).

3 Visto does not cite any cases which permit the use of new matter added to the written
4 description of a continuation-in-part application to expand the scope of the parent application. In
5 Jonsson v. The Stanley Works, 903 F.2d 812 (Fed. Cir. 1990), there were two sibling patents
6 (the '251 and '912 Patents) which shared a common parent application (the '008 Application).
7 Id. at 817. The court used the prosecution history of the parent '008 Application and the
8 previously-issued sibling '251 Patent to construe the claims of the '912 Patent. Id. at 817-18. In
9 Abtox, Inc. v. Exitron Corp., 122 F.3d 1019, 1027 (Fed. Cir. 1997), as amended, 131 F.3d 1009
10 (Fed. Cir. 1997), the court cited Jonsson for the proposition that "prosecution history of parent
11 application is relevant to understanding scope of claims issuing in a continuation-in-part
12 application." The Court proceeded to use the prosecution history of the parent application to
13 construe the claims of the child patent. Id. at 1009 ("To properly construe the claims, the district
14 court needed only to focus on the meaning of the claim language 'gas-confining chamber' as
15 interpreted in light of the specification and the parent application.").

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18 In neither case cited by Visto, nor in any other that Sproqit has found, did the court use
19 new matter from the written description of a continuation-in-part application to construe the
20 claim of the parent patent. Indeed such an approach would effectively allow a patentee to use
21 continuation-in-part applications to retroactively expand the disclosure of the parent application,
22 in violation of the written description requirement. For these reasons, the Court should not
23 consider new matter from the written descriptions of later-filed patent applications when
24 construing claim 10 of the '192 Patent.
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Respectfully submitted

DORSEY & WHITNEY LLP

Dated: February 3, 2006

/s/

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